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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,062	12/23/1999	TADASHI OHASHI	1341.1037/JD	8272
21171	7590	03/04/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			NGUYEN, MAIKHANH	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/472,062

Applicant(s)

OHASHI, TADASHI

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 10/24/2004 to the original application filed 12/23/1999.
2. Claims 1-11 are currently pending in this application. Claims 1, 6, and 9 have been amended. Claims 1, 6 and 9 are independent claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in claims 1, 6 and 9:

Art Unit: 2176

- a. an upper hierarchy layer and lower hierarchy layer ranked below the upper hierarchy layer where document files in the lower hierarchy are referenced above in the upper hierarchy layer; and
- b. the document in the upper hierarchy layer is separate and distinct from the document in the lower hierarchy layer.

Dependent claims 2-5, 7-8, and 10-11 are rejected for fully incorporating the deficiencies of their base claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 and 5-11 remain rejected under 35 U.S.C. 103(a) as being unpatentable over

Serbinis et al. (U.S. 6,584,466 – filed 04/1999) in view of **Usdin et al.** “XML: Not a Silver Bullet, But a Great Pipe Wrench”, 09/1998.

As to independent claim 1:

- a. Serbinis discloses an integrated document management system (*e.g., document management system; col.3, lines 14-19*) comprising:

- (i) a storage unit (*e.g., store 30; col.5, lines 47-49*) which stores therein a document database (*e.g., database 25; col.5, lines 27-62*) comprising plurality of documents that are files (*e.g., electronic documents or files; col.5, lines 35-37*) together forming a hierarchical structure (*e.g., hierarchical storage scheme for storing electronic documents; col.7, lines 16-22*) comprising an hierarchy upper layer and hierarchy lower layer ranked below the upper the upper hierarchy layer where document files in the lower hierarchy are referenced above in the upper hierarchy layer (*see Fig.3 and the associated text*), where the structure is defined with hypertext described in an extended markup language (*e.g., XML; col.16, lines 1-25*);
- (ii) a management information database comprising management information (*col.9, lines 19-32*), the document in the upper hierarchy layer is separate and distinct from the document in the lower hierarchy layer (*e.g., DMS system 17 ... supports multiple versions of documents ... maintain the relationships between the documents; col.7, lines 42-57*);
- (iii) a server connected to said storage unit (*e.g., store 30 is connected to server computer; col.5, lines 36-47 & Figs. 1A-B*) and provided a manager of the documents (*e.g., control data concerning documents; col.5, lines 27-28*); and
- (iv) a client connected via a network to said server (*e.g., one or more separate computers connected to server computer; col.5, lines 63-67*) and retrieves together, based on the management information, by accessing said server

(e.g., the electronic document then maybe retrieved by one or more Authorized Users ...The specific access rights granted to each Authorized Users are recorded in the document tables of DMS database 25; col.8, lines 67-col.9, line 32), the document in the upper layer and the document in the lower layer each having a specified version number from the document database (e.g., Document instance records are created when new documents or new versions of existing documents are stored to the DMS system; col.7, lines 51-54).

- b. Serbinis does not explicitly teach “an XML file defining the hierarchical structure by indicating a relation between a document in the upper hierarchy layer and document in the lower hierarchy layer, a document type definition file describing information on a version number of each document, and a document style sheet file defining a style of each document.”
- c. Usdin discloses an XML file defining the hierarchical structure by indicating a relation between a document in the upper layer and a document in the lower layer *(e.g., XML assumes that data are hierarchically structured ... which consist of name ‘root’ element which begins at the beginning of the document ...The hierarchical structure is fairly obvious in text documents ... a section starts ... the same level ...A section ...subsections; page 126), a document type definition file describing information on a version number of each document (e.g., Document Type Definition ...specify what the root element is for a document type ... define the contents of elements ... define relationships among the contents of various*

elements; page 127; right column – page 128, left column), and a document style sheet file define a style of each document (e.g., The language for stylesheets for XML documents; page 128, right column).

- d. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Usdin in the system of Serbinis because Usdin's teaching would have provided the capability for describing the structure and syntax of XML documents, and identifying all of the types of information that are needed for searching, retrieving, formatting, and tracking.

As to dependent claim 2:

Serbinis discloses the management information includes information indicating a collection of a plurality of documents in a on the same layer (*e.g., Document objects 72A and 72B represent a generalized high level description of a document; col.7, lines 28-32*) and version number of the plurality of documents, and said client retrieves, based on the management information, by accessing from said server the collection of the plurality of documents in the same layer, the documents retrieved each having a specified version number, from the document database (*e.g., hierarchical storage scheme for storing electronic documents ... a generalized high level description of a document ...DMS system 17 also preferable supports multiple versions of documents ...the parent and child document instance, a version name and a unique version ID; col.7, lines 17-62 & Fig.3).*

As to dependent claim 5:

Serbinis discloses the management information includes information concerning a security level corresponding to each of the plurality of documents and said server permits or inhibits retrieval of the document according the security level (*col.7, lines 8-62 & Abstract & Fig.2*).

As to independent claim 6:

The rejection of independent claim 1 above is incorporated herein in full.

As to dependent claim 8:

It includes the same limitations as in claim 5, and is similarly rejected under the same rationale.

As to independent claim 9:

The rejection of independent claim 1 above is incorporated herein in full.

As to dependent claims 7 & 10:

They include the same limitations as in claim 2, and are similarly rejected under the same rationale.

As to dependent claim 11:

It includes the same limitations as in claim 5, and is similarly rejected under the same rationale.

5. Claims 3-4 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Serbinis et al.** in view of **Usdin et al.** as applied to claim 1 above, and further in view of **Hashimoto et al.** (U.S. 5,893,114 – filed 11/1996).

As to dependent claim 3:

- a. The combination of Serbinis and Usdin does not explicitly disclose “the server registers, when a document registered in the document database is updated, the updated document in the document database, and also updates the version number information in the management information concerning the document.”
- b. Hashimoto discloses the server registers, when a document registered in the document database is updated, the updated document in the document database, and also updates the version number information in the management information concerning the document (*e.g., the document once registered ... the document is periodically updated; col.5, lines 15-52 & Fig.12*).
- c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Hashimoto’s teaching in the system of Serbinis as modified by Usdin because Hashimoto’s teaching would have provided the enhanced capability for automatically storing a referred electronic document in a database and notifying new information to a user.

As to dependent claim 4:

- a. Serbinis discloses said client sends via the network to said server retrieval information for a document that has been retrieved (*Fig. 1B*).
- b. The combination of Serbinis and Usdin does not explicitly disclose “said server sends, when a document corresponding to the retrieval information is updated, updating information related to the document updated.”
- c. Hashimoto discloses said server sends, when a document corresponding to the retrieval information is updated, updating information concerning the updated

document via the network to said client (*e.g., server is always accessed to acquire the latest document data; col.5, lines 36-45*).

- d. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Hashimoto's teaching in the system of Serbinis as modified by Usdin because Hashimoto's teaching would have provided the enhanced capability for automatically storing a referred electronic document in a database and notifying new information to a user.

Response to Arguments

6. Applicant's arguments filed 10/24/2004 have been fully considered but they are not persuasive.

Applicant argues that *the rejection does not discuss where Serbinis or any other prior art reference discloses retrieving two documents together based on management information that defines the retrieved-together documents belong*. (Remarks, page 8)

In response, Serbinis teaches retrieving two documents together (the electronic document may be retrieved by one or more Authorized Users. In this context, one or more documents could be retrieved together by different authorized users) based on management information (some Authorized Users may be granted only to retrieve and review a document, while others are granted access to retrieve and modify the document; col.9, lines 25-28).

Applicant argues that claim 1 has an XML file which defines a hierarchy of different distinct document files. Hierarchical structure of XML elements within a document (Serbinis) is not the same as defining a hierarchy of document using a different XML ...whereas the hierarchy described in Usdin is only a hierarchy of XML elements within a single document or file. (Remarks, page 9)

In response, Serbinis teaches a hierarchy of different distinct document files (hierarchical storage scheme for storing electronic documents; col.7, lines 17-19 & Document group records may be created when logical collections of documents are stored at the same time and it is desired to maintain the relationship between the documents; col.7, lines 54-57). The hierarchy in Usdin is a hierarchy of XML document elements. However, the elements could be called “documents” (Usdin page 126, right column).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

Art Unit: 2176

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (571) 272-4090.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen
February 18, 2005


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER